

REMARKS

Applicant hereby amends claims 29, 38, 42, and 43, cancels claims 1-28, 30, 39-41, 49, and 50 without prejudice or disclaimer, and adds new claims 51-54. Claims 34-37 are withdrawn as being directed to a non-elected species. Claims 29, 31-33, 38, 42-48 and 51-54 are pending and under examination in the application, with claims 29 and 38 being in independent form.

In an Office Action, the Examiner rejected claims 1, 2, 10, 13, and 38-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,852,434 to Sekendur (“Sekendur”); rejected claims 3, 11, 12, and 29-33 under 35 U.S.C. § 103(a) as being unpatentable over *Sekendur* in view of U.S. Patent No. 7,098,894 to Yang et al. (“Yang”); and rejected claims 49-50 under 35 U.S.C. § 103(a) as being unpatentable over *Sekendur* in view of U.S. Patent Application Publication No. 2002/0163511 to Sekendur. Applicant has canceled claims 1-28, 30, 39-41, 49, and 50, thereby rendering the rejections of those claims moot. For the reasons discussed below, Applicants respectfully traverse the rejections of the pending claims.

§ 103(a) Rejection of Claims 38 and 42-48

Applicants respectfully traverse the rejection of claims 38 and 42-48 under 35 U.S.C. § 103(a) as being unpatentable over *Sekendur*. A *prima facie* case of obviousness has not been established.

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the

prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Amended independent claim 38 recites a "modular unit for an electronic pen having a writing implement" including, amongst other elements, "an imaging unit designed to control a spatial origin of radiation reaching the radiation sensor, the imaging unit defining an image plane and an object plane, the imaging unit having a body and a holder," and "a radiation source . . . being held by the holder of the imaging unit." As described by way of example in the specification, when the radiation source is mounted in a holder on the imaging unit:

[A] short tolerance chain and, consequently, a well-defined relationship is obtained between the irradiating system and the imaging system. Further, by attaching the radiation source to the boresight unit, the radiation source may be brought sufficiently close to the object plane of the imaging system for the radiation guide to be omitted. By dispensing with the radiation guide, the complexity and cost of the optical system may be reduced.

Specification, page 44.

At page 7 of the Office Action (addressing former claim 41), the Examiner "interpret[ed] whatever holds the optical components in the desired arrangement as being part of the imaging unit." It is not clear what "optical components" in *Sekendur* the Examiner is addressing, but *Sekendur* does disclose "optical element 19 . . . optically formed to read close to the surface," and that "[a]t the bottom of the optical element is a lens, lens shade, and/or light filter 20" and "[o]ptionally, the scanning end comprises an interchangeable lens, lens shade, and/or light filter 12." *Sekendur*, col. 6, ll. 29-35. However, what positions optical element 19, lens 20, or lens 12 does not constitute (nor

do optical element 19, lens 20, and/or lens 12 constitute) “an imaging unit” that is “designed to control a spatial origin of radiation reaching the radiation sensor,” that “defin[es] an image plane,” and that also “ha[s] a body and a holder” that holds a radiation source. Nor does *Sekendur* elsewhere teach such an imaging unit.

Moreover, *Sekendur* does not teach the unique combination including a holder for a radiation source, where the holder is associated with an outer part of an imaging unit body. Rather, in *Sekendur*, light source 17 is coupled to interface means 14 (see Fig. 7) or attached to the exterior of pen-shaped optical conduit 8 (see Fig. 6).

Sekendur thus does not teach a radiation source held by a holder that is part of an imaging unit designed to control a spatial origin of radiation reaching the radiation sensor, where the holder is associated with an outer part of the imaging unit body and the imaging unit is part of a modular unit for an electronic pen as in claim 38.

In the context of this rejection, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Nor does the Office Action clearly articulate a reason why claim 38 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above, and Applicants respectfully request that the Examiner withdraw the rejection of independent claim 38, as well as its dependent claims 42-48, under 35 U.S.C. § 103(a).

§ 103(a) Rejection of Claims 29 and 31-33

Applicants respectfully traverse the rejection of claims 29 and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over *Sekendur* in view of *Yang*. A *prima facie* case of obviousness has not been established.

Amended independent claim 29 recites a “sensor boresight unit for transmitting radiation from an object to a radiation sensor” that includes the unique combination including “a housing,” “a lens,” “a mirror,” and “a holder for receiving a radiation source, said holder being associated with an outer part of the housing.” While *Sekendur* discloses a “light source 17” that “is optionally placed at the upper or lower end of the stylus,” (*Sekendur*, col. 5, ll. 17-18), *Sekendur* fails to teach the unique combination of claim 29, and specifically “a sensor boresight unit for transmitting radiation from an object to a radiation sensor” having, amongst other elements, “a holder for receiving a radiation source” that is “associated with an outer part of the housing.”

As discussed above in connection with claim 38, *Sekendur* discloses light source 17 is coupled to interface means 14 (see Fig. 7) or attached to the exterior of pen-shaped optical conduit 8 (see Fig. 6). *Sekendur* does not however, teach “a holder for receiving a radiation source, said holder being associated with an outer part of [a] housing” that is part of a “sensor boresight unit” as is recited in amended claim 29. *Yang* does not cure this deficiency of *Sekendur*, as *Yang* teaches illumination unit 11 and light guide 12 are separate from and not held by imaging system 13. See *Yang* at Fig. 4.

In view of the above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior

art and the claimed invention. Furthermore, the Office Action has failed to clearly articulate a reason why claim 29 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for at least the reasons discussed above and the Examiner should withdraw the rejection of independent claim 29, as well as its dependent claims 31-33, under 35 U.S.C. § 103(a).

New claims 51-54

Applicants respectfully request consideration and allowance of new claims 51-54, which depend from allowable claims 29 and 38. In addition, these new claims are allowable because they further recite features not disclosed, taught or suggested by the cited references. Claims 51 and 52 depend from claim 29 and recite the novel features that the holder is “integrated with the outer part of the housing,” (claim 51) or “attached to the outer part of the housing” (claim 52). Claims 53 and 54 depend from claim 38 and recite the novel features that the holder is “integrated with the outer part of the body,” (claim 53) or “attached to the outer part of the body” (claim 54). Support for new claims 51-54 can be found on page 45 of the specification.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Examiner requested that Applicants indicate where support can be found in the priority documents for a limitation should Applicants reference drawings 14-19 as providing support for a particular limitation. Although Applicants have not specifically

referenced Figures 14-19 in this Reply and have not indicated where in the priority documents such material is supported, Applicants expressly reserve the right to provide such support at a later time should such support be necessary, for example, to antedate a reference.

The Office Action contains characterizations of the invention and the cited art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

Through this Amendment, Applicants have attempted to place this application in condition for allowance. If the Examiner foresees any impediments to allowance, the undersigned would welcome a phone call from the Examiner to resolve any outstanding issues.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 16, 2009

By: Kay Henry Hill
Kay H. Hill
Reg. No. 62,833
(202) 408-4000